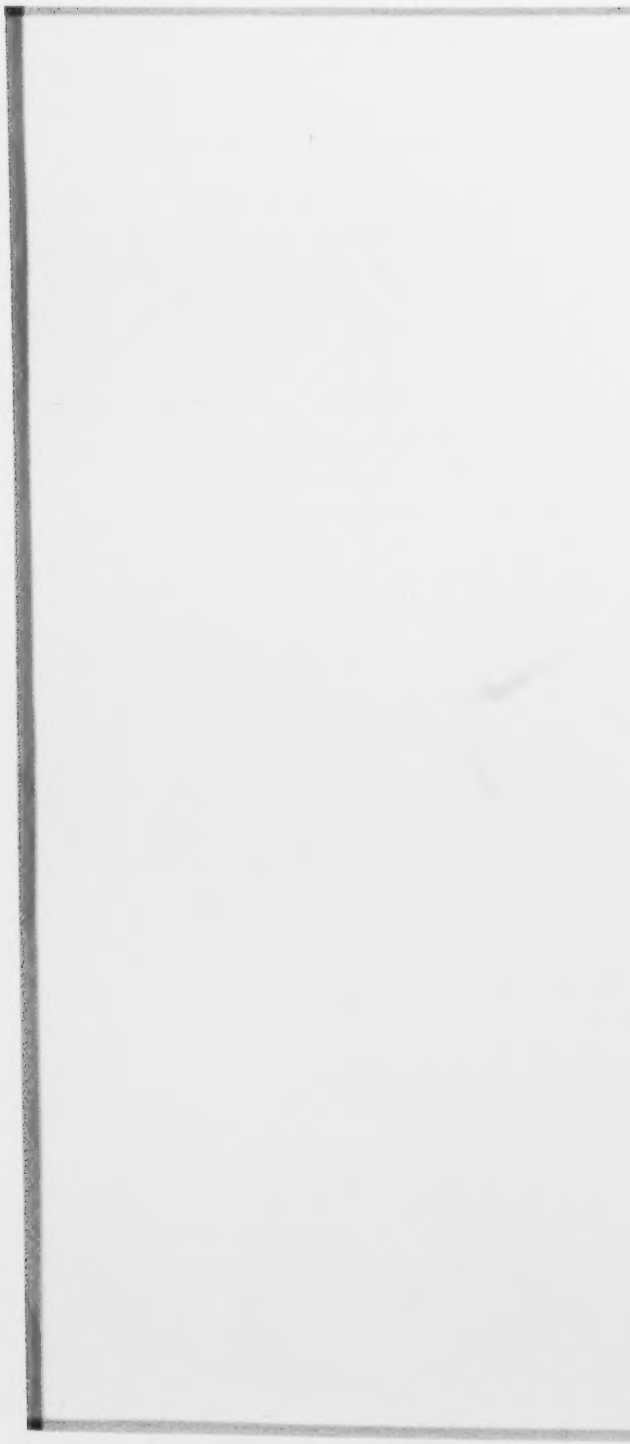

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the Eastern District of Tennessee was filed November 8, 1938, appears on pages 229-236 of the record, and was reported in 25 Fed. Supp. 464. The opinion of the Circuit Court of Appeals for the Sixth Circuit was filed May 8, 1940, appears at pages 723-730 of the record, and was reported in 111 F(2nd) 584.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the Circuit Court of Appeals for the Sixth Circuit which petitioner seeks to have reviewed was entered May 8, 1940 (R. p. 722). Thereafter, a petition was filed for rehearing (R. p. 732), which was denied on June 6, 1940 (R. p. 740).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari. Any necessary elaboration of the facts will be made in the course of the argument which follows.

Specification of Errors

The errors which petitioner will urge, if the writ of certiorari is issued, are that the Circuit Court of Appeals for the Sixth Circuit erred:

1. In holding that the typewritten thesis prepared by the patentee summarizing his experimental work at Iowa State College and deposited in the library of the college, constitutes a printed publication under the provisions of R. S. 4886, 35 U. S. Code, Sec. 31.

2. In holding that the claims of the patent in suit are invalid because they include within their scope compounds of the designated class in addition to those specifically employed.

3. In holding that the claims of the patent are invalid because directed to a discovery made pursuant to chemical research in an indicated field.

4. In holding that the claims of the patent in suit were anticipated by Kharasch U. S. Patent No. 1,770,886 cited by the Patent Office against the patentee's prior and abandoned application.

5. In affirming the decree of the District Court in favor of respondent and holding the patent in suit invalid.

Summary of Argument.

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari and will be discussed in the order set out in the petition (ante, pp. 4-5).

ARGUMENT.

I.

THE TYPEWRITTEN THESIS (Rec. p. 413) DEPOSITED BY THE PATENTEE IN THE IOWA STATE COLLEGE LIBRARY WAS NOT A PRINTED PUBLICATION WITHIN THE MEANING OF R. S. 4886, U. S. CODE, TITLE 35, SEC. 31.

So far as we are aware, this Court has never had occasion to construe the phrase "printed publication" of R. S.

4886 in its application to facts in any way analogous to those here presented.

In *Corona* v. *Dovan,* 276 U. S. 358, the invention of the patent in suit had been described in detail in a paper read before the American Chemical Society more than two years prior to the application for the patent. The District Court held that this paper so read did not constitute a printed publication within the meaning of the statute, and that ruling was not assigned as error in the later proceedings in the case.

The two cases relied upon by the Court of Appeals for the Sixth Circuit in support of their opinion are not in fact relevant to the question presented. In *John Crossley & Sons, Ltd.,* v. *Hogg,* 83 Fed. 488, the patent in suit was a design patent. The ground of rejection was a lithographic plate contained in a printed book published in Paris. The lithographic plate was not printed in the sense of containing letter press. It was a cut or diagram showing a carpet pattern which the Court found anticipatory of the carpet pattern constituting the subject-matter of the design patent. There was no question that the anticipating illustration of the design was part of a printed publication, in fact that question seems not to have been raised.

In *Britton* v. *White,* 61 Fed. 93, the question presented was whether an illustration of a carriage lamp in "The Coachmaker's Monthly Magazine" was an anticipation. The Court said (p. 95):

> "I think the Saladee Coachmaker's Monthly Magazine is admissible as a printed publication, to show the state of the art. The number containing this lamp in question has printed on it, 'New York, April, 1855', is bound up with other numbers for the years 1855 and 1856, and refers to its advertisements, and gives terms therefor. It purports to be printed for general circulation, and is characterized as a publication by the witnesses for defendant. These circumstances furnish sufficient prima facie evidence of publication."

There seems to be no sound basis for the decision of the Court of Appeals for the Sixth Circuit holding this thesis to be a printed publication. The expression "printed publication" has a very definite meaning, both legally and in the ordinary useage of the language. Giving the words their ordinary and intended significance, a printed publication is a magazine, book, newspaper, or the like, intended for general distribution, which is the obvious and correct interpretation of the statute as expressed in the language of the Court in *Britton* v. *White,* supra.

It is important that this Court review this decision of the Court of Appeals for the Sixth Circuit. Industrial development in modern times is largely founded on research, and this research frequently involves several years of intensive work before commercial results are obtained. Against the defense of prior knowledge or prior use, the inventor may show his own priority and his diligence in perfecting his invention. Against a "printed publication" of a date more than one year prior to his patent application, he has no defense, and if the decision of the Court of Appeals with respect to the patentee's thesis is a correct interpretation of the law, patents to many valuable inventions will be invalidated.*

Moreover, the decision of the Circuit Court of Appeals for the Sixth Circuit puts all these thousands of college papers not only in this country, but throughout the world, in the "prior art" and thus enormously increases the field of search in which anticipatory matter may be found. Obviously no such conditions were contemplated by the framers of the statute.

***In the present case the thesis (R. p. 413) does not disclose the invention of the patent. It was written at too early a stage in the course of the inventor's research and fails to disclose certain essential characteristics of the invention which had not been discovered at that time.**

II.

PATENT CLAIMS TO A DEFINED GROUP OF CHEMICAL COMPOUNDS POSSESSING THE ESSENTIAL CHARACTERISTICS FOR THE STATED PURPOSE ARE NOT INVALID. (*The Incandescent Lamp Patent,* 159 U. S. 465)

The pertinent facts as found in the Court's opinion are:

There are a great many possible compounds falling within the broad definition of organic mercury compounds (Rec. p. 201), although probably not over thirty or forty ever got beyond the stage of a laboratory sample (R. 214). In this vast field the patentee discovered a smaller, well defined class of related products having certain features in common, namely, that the mercury was contained in the same combined form and that they had a similar action upon solution in water. The compounds within this class had extraordinary germicidal power and yet were inoccuous to man when administered in concentrations to be lethal to pathogenic germs. The patentee discovered these characteristics in one substance in this class by the usual process of laboratory research (Rec. pp. 112, 443). He attributed the effectiveness of the compound to those characteristics which identified the compound with the defined group. That deduction was confirmed by making up and trying out some twenty other compounds belonging to the defined group, and they were found to possess the same characteristics (Rec. p. 28). He therefore sought and obtained under the established practice of the Patent Office a patent, listing a number of the specific individual compound which had been used and claiming the defined group. The rule of the Patent Office is thus stated in a typical decision of the Board of Appeals:

> *Ex Parte William C. Geer and Harry L. Fisher,* 3 U.S.P.Q. 131, 132:

> "The second test applies where the class and reaction are not so clearly defined and involved. In such case it is required that applicant give a number of examples of compounds which he has found to be operative in the relation involved in his invention. If these several tested materials appear to have some characteristic in common which is the essential characteristic which makes them operative in the relation involved so that it may be expected that other members of that class of materials would act the same, he may have a claim broad enough to include that class."

The rule was established by the Court of Appeals for the District of Columbia when that Court had appellate jurisdiction in Patent Office cases (*In re Ellis*, 37 App. D.C. 203) and has been restated by the Court of Customs and Patent Appeals (*In re Walker*, 70 F(2nd) 1008).

Although apparently the question has not been passed upon directly by this Court, the Patent Office rule is founded on the opinion of this Court in the Incandescent Lamp Patent (159 U. S. 465), which was quoted with approval in *Corona* v. *Dovan*, supra.*

The state of facts presented by this case is becoming more and more common with the great advance in industrial chemistry, particularly in the production of synthetic products. There should be an authoritative ruling by this Court on this question, decided, as we submit, in error by the Circuit Court of Appeals for the Sixth Circuit.

***In both these cases this Court held claims to a class of substances invalid because it was shown that there was "no general quality" common to the whole class and that many substances within the defined class were in fact useless.**

III.

THE CLAIMS OF THE PATENT ARE NOT INVALID BECAUSE BASED ON A DISCOVERY MADE IN THE COURSE OF RESEARCH IN A FIELD RECOMMENDED FOR STUDY IN A PRIOR PUBLICATION. (*Corona* v. *Dovan*, 276 U. S. 358)

This publication, the White article is entitled "New Organic Mercurials and Their Therapeutic Applications". None of the "new organic mercurials" discussed in the article are within the group claimed by the patentee here. The entire pertinency of the article is found in two paragraphs in the introduction, which paragraphs are quoted in full in the opinion of the District Court (Rec. pp. 234-5) and repeated in the opinion of the Circuit Court of Appeals (Rec. pp. 726-7). On the basis of these introductory paragraphs the lower Court held the White article

> ". . . pointed out the whole field in which organic mercury might or might not produce compounds of such tolerable toxicity. He told those interested in the art, in effect, to take his formulae and try the various combinations within the permitted substituent groups, of which he gave a typical illustration, and that the whole story of pharmacological mercurials would unfold." (R. p. 235)

This ruling was affirmed by the Court of Appeals (Rec. p. 727).

We doubt if the White article can be so interpreted. The only suggestion as to experimentation in the entire article is in the last sentence of the matter relied upon by the Court, wherein the author, after stating that nothing of therapeutic value had been found in one general group of organic mercurial compounds, said (R. p. 625):

> "Our consideration then narrows down to substances of the first group. This is a limitation of type but not of number, for when we consider that in the group

> R we may substitute single groups or concatenations of any complexity we see that the whole gamut of aromatic chemistry may be run in the synthesis of mercurials for pharmacological study."

If this petition be granted, we shall argue that the White article was not even an invitation to experiment in the field of organic mercurials, but assuming that it was, it is our position that the decision of the Circuit Court of Appeals was in error in not holding that discoveries made in the course of research are patentable discoveries, regardless of what prompted the research, *if the thing discovered has new, useful and unique properties,* as was found by the District Court in the present case (Finding of Fact No. 21, R. pp. 240-241).

In the case of *Corona* v. *Dovan, supra,* this Court specifically so ruled. Counsel for petitioner in that case contended (276 U. S. 362):

> "To a chemist familiar in 1918 with the guanidines in general and triphenylguanidine in particular, the most natural thing in the world would have been to think of diphenylguanidine [D. P. G.] as usable for the same purpose, and every rubber chemist would have known that the only way to find out would be to try it according to the routine methods of laboratory testing."

The Court held against petitioner on this point (p. 369):

> "If employment of D.P.G. as a useful accelerator was a discovery by Weiss, prior to anyone else, Weiss, or his assignee, is entitled to all the advantages that flow from that increased activity or from any other quality in its use as such."

In its opinion (R. p. 728) the Court of Appeals, in commenting on the patentee's research which resulted in the patented discovery, said:

> "There is no convincing evidence of seemingly insuperable difficulties encountered on the road, of blind alleys, and unmarked forks, of advances and retreats, of trials and failures."

The Courts have frequently held that it is the nature of the discovery and not the trials and tribulations of the discoverer which determines the patentability of the discovery. Congress, in the report of the Senate Committee accompanying the recent revision of the patent laws to include the plant patent sections, so interprets the statute:

> "The inventor of a composition of matter may have definitely in mind the new product and definitely worked toward it. On the other hand, as is true of many of the most important inventions, he may accidentally discover the product, perhaps in the course of the regular routine of his work. He does not have to show, for instance, that he mixed the elements and expected them to produce the particular composition of matter. He *may simply find the resulting product* and have the foresight and ability to see and appreciate its possibilities and to take steps to preserve its existence.
>
> The same considerations are true of the plant breeder." (71st Congress, 2nd Session-Report No. 315, p. 11).

If the ruling of the Circuit Court of Appeals in this case be given general application, evidence in patent cases will not be directed to establishing the novelty and utility of the thing invented or described, but will consist of an elaborate recital of all the fruitless efforts that preceded the discovery.

IV.

THE PATENTEE IS NOT ESTOPPED TO CONTEST THE PERTINENCE OF A PRIOR PATENT CITED DURING THE PATENT OFFICE PROSECUTION OF A COMPANION APPLICATION. (*Smith* v. *Snow*, 294 U. S. 1)

The conflict in the Court's decision (Rec. p. 730) on this point with the rulings of this Court is in the significance attached to the citation of this patent by the Patent Office in the prosecution of a prior application which was subsequently abandoned. This Court has ruled that the cancellation of the rejected claims of an application is without significance where broad claims are ultimately obtained.

> *Smith* v. *Snow*, 294 U. S. 16:
> "It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader Claim 1. *Westinghouse Electric & Mfg. Co.* v. *Condit Electrical Mfg. Co.*, 194 Fed. 427, 430 (C.C.A. 2d)."

The same rule obviously applies whether the claims ultimately obtained issued on the original application or on a later filed substitute application.

If this petition be allowed we will urge error in this finding also on the ground that, as shown by the evidence in the case, sterilizing seeds for agricultural purposes and combatting pathogenic germs in human diseases are non-analogous arts.

Conclusion

It is urged that this petition for certiorari be granted and that an authoritative ruling by this Court be made on each of the four questions here presented.

Respectfully submitted,

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